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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Carlson et al.

Assignee: Maxtor Corporation

Title: DISK DRIVE WITH IMPROVED TECHNIQUES FOR DETECTING HEAD FLYING HEIGHT (AS AMENDED)

Serial No.: 09/224,202 Filed: December 30, 1998

Examiner: Snizek, A. Group Art Unit: 2753

Atty. Docket No.: 3123-233-1



TC 2700 MAIL ROOM

ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

**PETITION FOR WITHDRAWL OF REQUIREMENT
TO STATE FIGURES AND FOR CLARIFICATION OF
CLAIM GROUPING**

Dear Sir:

This Petition is filed under 37 C.F.R. § 1.182 to request that the outstanding restriction requirement (1) withdraw the requirement to state figures and (2) clarify the claim grouping.

The captioned-application was filed on December 30, 1998. The original application contained claims 1-46. A first Preliminary Amendment which accompanied the application canceled claims 21-46.

A second Preliminary Amendment was filed on May 25, 1999. The second Preliminary Amendment canceled claims 1-20 and added claims 47-106.

An Office Action was sent on October 22, 1999, in which a restriction requirement was issued and explained as follows:

This application contains claims directed to the following patentably distinct species of the claimed invention: There appears to be 5 distinct arrangements used to determine the acceptable flying height of a head as pointed out by Brief Description of the Drawings (figures 3-5, figure 6, figure 7, figure 8 and figure 9 along with corresponding disclosure).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Since the Examiner mentioned five distinct arrangements, Applicant presumed there was a five-way restriction requirement. However, the Examiner did not specify which claims belonged to which species. Furthermore, six independent claims (47, 57, 67, 77, 87 and 97) were pending.

Based on a review of the six independent claims, Applicant's best guess of the intended claim grouping was as follows:

<u>Claims</u>	<u>Group</u>
47-56	I
57-66	II
67-76	III
77-86	IV
87-106	V

Rather than second-guess the Examiner, the undersigned attorney called the Examiner and asked whether the grouping listed above was what the Examiner had intended. The Examiner indicated he did not wish to discuss the claim grouping over the telephone and asked that Applicant submit the claim grouping and election of species in a written response.

A Response was filed on November 2, 1999. In the Response, Applicant indicated that the following claim grouping was presumed:

<u>Claims</u>	<u>Group</u>
47-56	I
57-66	II
67-76	III
77-86	IV
87-106	V

Applicant also elected claims 87-106 (Group V) and requested that the Examiner confirm the claim grouping in the next written communication.

The outstanding Office Action was sent on January 18, 2000. The outstanding Office Action states as follows:

The reply filed on 11/10/1999 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Applicant has not elected one of the species referred to in the specification and as outlined by examiner in the previous office action. Examiner acknowledges that applicant has stated that he wishes to prosecute claims 87-106 in this application, however applicant has not stated which figure or figures, i.e., which specie is elected. See 37 CFR 1.111.

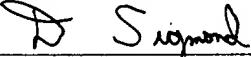
This Petition is filed for two reasons. First, the Examiner has yet to specify the claim grouping in the restriction requirement. Second, the Examiner is requiring that Applicant specify figures as an election of species. Applicant does not understand how to specify figures for an unknown claim grouping. Further, even if the Examiner specified the claim grouping (or confirmed Applicant's presumed claim grouping), Applicant believes it is improper for the Examiner to require that Applicant match up various figures with claim groups in response to a restriction requirement.

The Examiner appears to be attempting to shift the responsibility for defining the restriction requirement from himself to the Applicant. Applicant is not aware of any authority that supports this role reversal.

In sum, Applicant has attempted to clarify the claim grouping in the restriction requirement and has submitted a provisional election. In this Petition, Applicant respectfully requests that the Examiner (1) withdraw the requirement that Applicant specify figures in response to the restriction requirement, and (2) clarify the claim grouping in the restriction requirement.

Finally, as a minor matter, Applicant filed a Change of Correspondence Address on February 9, 1999. The Office Action dated October 22, 1999, was sent to the new correspondence address, however the outstanding Office Action was sent to the earlier correspondence address. Applicant respectfully requests that all correspondence be sent to the new correspondence address.

Please charge any fee due under this Petition to Deposit Account No. 13-0016/233-1.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on February 4, 2000.	
 _____ David M. Sigmond Attorney for Applicant	<u>2 / 4 / 00</u> Date of Signature

Respectfully submitted,



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